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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/768,509
Filing Date: January 30, 2004
Appellant(s): LAZARIDIS ET AL.

Mr. Joseph M. Sauer
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 9/18/2009 appealing from the Office action mailed 12/4/2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct. It is noted, however, that the alleged specification support provided for "without the user having entered a delimiter denoting an end of the text string" in independent claim 48 (*Appeal Brief, Pages 5-6*) is completely silent regarding any type of delimiter.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct with the exception of the new grounds of rejection.

NEW GROUND(S) OF REJECTION

Claim 48-50 stand rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,974,413	BEAUREGARD et al	10-1999
6,288,718	LAURSEN et al	9-2001
6,622,119	RAMASWAMY et al	9-2003
7,216,292	SNAPPER et al	5-2007

Eide, E.N. "Valet: An Intelligent Unix Shell Interface" Master's Thesis, University of Utah, August 1995, pp. 1-147.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 5, 9-13, 37, 41-45, and 48-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beauregard et al (*U.S. Patent: 5,974,413*) in view of Eide (*"Valet: An Intelligent Unix Shell Interface," 1995*) and further in view of Laursen et al (*U.S. Patent: 6,288,718*).

With respect to **Claim 2**, Beauregard discloses:

Receiving an abbreviated textual command in a natural language search engine (*text input, Col. 7, Line 58- Col. 8, Line 49; command code words, Col. 15, Lines 18-58; and wordbase search, Col. 16, Line 65- Col. 17, Line 31*);

While receiving the abbreviated textual command performing the steps of:

Searching a natural language database that stores a data set of abbreviated textual commands and associated application commands (*searching a "wordbase" database containing command code words and associated service scripts, Col. 16, Line 65- Col. 17, Line 31*);

Displaying a list of probable complete commands matching the currently received portion of the abbreviated textual command (*displaying multiple commands in a window that may correspond to a entered command word, Col. 42, Lines 27-50*).

If a user selects a complete command from the list, then setting the complete command as the abbreviated textual command, and executing the associated

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application command (*selection of a displayed script command and script execution, Col. 43, Lines 1-13*).

Although Beauregard teaches a means for presenting a list of probable commands to a user and further discloses recording command history information (*Col. 17, Lines 16-31*), Beauregard does not specifically suggest utilizing the history information in determining the one or more probable commands. Eide, however, recites a means for determining probable input commands that utilizes a command history (*user input history used in determining a text command, Pages 28-31*). Eide further teaches the ability to perform a command search process similar to that of the claimed invention while receiving a textual input command (*pages 37-38*).

Beauregard and Eide are analogous art because they are from a similar field of endeavor in text command systems. Thus, it would have been obvious to one of ordinary skill in the art, at the time of invention, to modify the teachings of Beauregard with the means for determining probable input commands during text command reception utilizing a command history as taught by Ramaswamy in order to reduce tedium and typing errors in command entry while increasing command match frequency (*Eide, Pages 29 and 37*).

Beauregard and Eide do not specifically suggest text entry and list narrowing using a portable device, however, Laursen discloses a portable device that progressively reduces a list of potential text entries with each entered character and allows a user to at any time select a complete entry from the currently displayed list (*abstract; Col. 2, Lines 1-24; and Col. 6, Line 34-Col. 7, Line 12*).

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Beauregard, Eide, and Laursen are analogous art because they are from a similar field of endeavor in user interfaces utilizing text entry. Thus, it would have been obvious to one of ordinary skill in the art, at the time of invention, to modify the teachings of Beauregard in view of Eide with the portable device embodiment taught by Laursen in order to further extend the command entry system to other well-known types of portable computing devices (*text command invention is portable to any type of computer, Beauregard, Col. 43, Lines 23-31*).

With respect to **Claim 5**, Eide further recites:

If the abbreviated textual command has an exact match in the data set, then setting the exact match as a user command (*Pages 37-38*);

If the abbreviated textual command does not have an exact match in the data set, then analyzing historical preferences to determine if the abbreviated textual command has a probable match in the data set (*misspelled command corrections, Pages 94-95*);

If the abbreviated textual command has a probable match in the data set, then setting the probable match as the user command (*Pages 94-95 and returning a single probable command*);

If the abbreviated textual command does not have a probable match in the data set then presenting a list of possible command, receiving a command choice and setting the command choice as the user command (suggest probable command, Pages 94-95); and

Executing the command (*Pages 37-38*).

With respect to **Claim 9**, Beauregard further discloses:

The abbreviated textual command has a first component and a second component, wherein the first component represents a desired application command, and the second component represents a desired application tag (text command and application identifying tag, Col. 11, Lines 18-26); and

The natural language database stores a data set of abbreviated textual commands and associated application commands and tags (*database storing command text and application tags, Col. 34, Lines 8-18*).

With respect to **Claim 10**, Beauregard further discloses:

The abbreviated textual command is entered into a graphical dialog box (*action box, Col. 27, Line 66- Col. 28, Line 9*).

With respect to **Claim 11**, Beauregard further discloses:

The natural language search engine can receive the abbreviated textual command while any of the software applications are executing (*Col. 10, Lines 3-8*).

With respect to **Claim 12**, Eide further discloses utilizing history data in misspelling correction (*Pages 94-95*).

With respect to **Claim 13**, Eide further recites:

The list of possible commands includes a set of generic application commands (*Page 97*).

With respect to **Claim 37**, Beauregard discloses:

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Receiving an abbreviated textual command in a natural language search engine (*text input, Col. 7, Line 58- Col. 8, Line 49; command code words, Col. 15, Lines 18-58; and wordbase search, Col. 16, Line 65- Col. 17, Line 31*);

While receiving the abbreviated textual command performing the steps of:

Searching a natural language database that stores a data set of abbreviated textual commands and associated application commands (*searching a "wordbase" database containing command code words and associated service scripts, Col. 16, Line 65- Col. 17, Line 31*);

Displaying a list of probable complete commands matching the currently received portion of the abbreviated textual command (*displaying multiple commands in a window that may correspond to an entered command word, Col. 42, Lines 27-50*).

Although Beauregard teaches a means for presenting a list of probable commands to a user and further discloses recording command history information (*Col. 17, Lines 16-31*), Beauregard does not specifically suggest utilizing the history information in determining the one or more probable commands. Eide, however, recites a means for determining probable input commands that utilizes a command history (*user input history used in determining a text command, Pages 28-31*). Eide further teaches the ability to perform a command search process similar to that of the claimed invention while receiving a textual input command (*pages 37-38*) and displaying the probable subset of the complete commands to the user (*Page 37*).

Beauregard and Eide are analogous art because they are from a similar field of endeavor in text command systems. Thus, it would have been obvious to one of

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ordinary skill in the art, at the time of invention, to modify the teachings of Beauregard with the means for determining probable input commands during text command reception utilizing a command history as taught by Eide in order to reduce tedium and typing errors in command entry while increasing command match frequency (*Eide, Pages 29 and 37*).

Beauregard and Eide do not specifically suggest text entry and list narrowing using a portable device, however, Laursen discloses a portable device that progressively reduces a list of potential text entries if a user decides to keep entering letters and allows a user to at any time select a complete entry from the currently displayed list if the user decides to cease entry (*abstract; Col. 2, Lines 1-24; and Col. 6, Line 34-Col. 7, Line 12*).

Beauregard, Eide, and Laursen are analogous art because they are from a similar field of endeavor in user interfaces utilizing text entry. Thus, it would have been obvious to one of ordinary skill in the art, at the time of invention, to modify the teachings of Beauregard in view of Eide with the portable device embodiment taught by Laursen in order to further extend the command entry system to other well-known types of portable computing devices (*text command invention is portable to any type of computer, Beauregard, Col. 43, Lines 23-31*).

With respect to **Claim 41**, Eide recites:

When the probable subset consists of only one complete command, executing that one complete command (*Page 37*).

With respect to **Claim 42**, Beauregard further discloses uses-defined textual commands (*Col. 9, Lines 19-22*).

With respect to **Claim 43**, Eide discloses the command history information as applied to Claim 2.

With respect to **Claims 44-45**, Eide recites past commands selected more than half of the time (*Pages 29-30; Pages 37-38; Pages 94-95*).

Claim 48-49 contains subject matter similar to Claim 37, and thus, is rejected for the same reasons, wherein the lack of a need to enter a delimiter is taught by Laursen (*abstract; and Col. 2, Lines 1-24*).

With respect to **Claim 50**, Eide discloses the historical preference data used for text entry completion, as applied to Claim 37.

Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beauregard et al (*U.S. Patent: 5,974,413*) in view of Eide ("*Valet: An Intelligent Unix Shell Interface*," 1995) in view of Laursen et al (*U.S. Patent: 6,288,718*) and further in view of Ramaswamy et al (*U.S. Patent: 6,622,119*).

With respect to **Claim 6**, Beauregard in view of Eide and further in view of Laursen teaches the software application launching method utilizing history information, as applied to Claims 2 and 5. Beauregard in view of Eide and further in view of Laursen does not specifically suggest probability factors associated with historical command preferences nor the determination of a probably command as having greater than a threshold probability value however, Ramaswamy further discloses:

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The step of analyzing historical preferences is performed using a set of probability factors that are generated based on historical preferences, where the abbreviated textual command has a probable match in the data set when a probability factor associated with the probable match is greater than a predetermined value (*probabilities based on user history, Col. 5, Lines 19-45; Col. 6, Lines 11-28; and probability threshold, Col. 8, Lines 3-24*).

Beauregard, Eide, Laursen, and Ramaswamy are analogous art because they are from a similar field of endeavor in language command systems. Thus, it would have been obvious to one of ordinary skill in the art, at the time of invention, to modify the teachings of Beauregard with the means for determining probable input commands utilizing a command history as taught by Ramaswamy in order to achieve improved natural language understanding accuracy through the use of user regularity scores (*Ramaswamy, Col. 1, Lines 23-33*).

With respect to **Claim 7**, Ramaswamy further discloses:

The predetermined value is defined by a user (*predetermined threshold that would inherently be set by some type of user, Col. 8, Lines 3-24*).

With respect to **Claim 8**, Ramaswamy additionally recites:

Adjusting the set of probability factors each time the abbreviated textual command is entered into the hand-held device (*using input commands to adapt command prediction for a particular user, Col. 3, Lines 14-26; Col. 9, Lines 9-31*).

Claim 56 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beauregard et al (*U.S. Patent: 5,974,413*) in view of Snapper et al (*U.S. Patent: 7,216,292*).

With respect to **Claim 56**, Beauregard discloses:

A natural language search engine (*Fig. 4, Element 330*) configured to:

Receive a command text string being entered by a user, the text string being entered by a user while the user is in a first application, the text string being in two-part format with one part being an abbreviation for a software application and the other part being an abbreviation for an object of the application (*receiving two text command sections from a user, wherein a first part can comprise a software application and the second part can comprise a program object- multi-word commands, Col. 8, Lines 50-63; user-selected abbreviated natural language commands, Col. 15, Line 59- Col. 16, Line 6; example of activating a software program and performing an operation in the program based on a two part command, Col. 46, Line 55- Col. 47, Line 14; and "wordbase" database containing command code words and associated service scripts, Col. 16, Line 65- Col. 17, Line 31*);

Compare the text string to the user commands in the database, to determine which of the user commands matches with the text string (*command matching processing, Col. 17, Lines 16-30; and Col. 27, Lines 50-65*); and

Executing the matching user command by initiating the corresponding second application, whereby the user launches the second application from within the first application by entering the command string within the first application (*user commands*

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that can launch a new software applications from within a running application, Col. 10, Line 33- Col. 11, Line 16; and example of such an instance, Col. 44, Lines 40-67).

Although Beauregard teaches a means for presenting a list of probable commands to a user and further discloses recording command history information (*Col. 17, Lines 16-31; and Col. 34, Lines 3-43*), Beauregard does not specifically suggest utilizing the history information in determining the one or more probable text inputs or continually narrowing down a list of possible texts as text begins to be entered.

Snapper, however, recites a means for determining probable text inputs that utilizes a user history (*user input history used in determining a probable complete text entry, Col. 8, Lines 5-12; and Col. 13, Line 59- Col. 14, Line 5*). Snapper further teaches the ability to perform a text search process similar to that of the claimed invention while receiving a textual input and without the user having to enter a delimiter (*narrowing down of a list of displayed complete text entries with each successive character entry, Col. 10, Lines 45-60*).

Beauregard and Snapper are analogous art because they are from a similar field of endeavor in user interfaces utilizing text entry. Thus, it would have been obvious to one of ordinary skill in the art, at the time of invention, to modify the teachings of Beauregard with the means for determining probable text entries during text input reception utilizing a user history as taught by Snapper in order to reduce the need for a user to repeatedly enter a complete text entry (*Snapper, Col. 1, Lines 25-34*), thus enabling more efficient command entry.

NEW GROUND(S) OF REJECTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 48-50 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Independent claim 48, recites the limitation “without the user having entered a delimiter denoting an end to entry of the abbreviated textual command”, which is not disclosed in the specification. An attempt was made by the examiner to find the basis for such a limitation in the specification, but no basis was found. The specification does not use or define the term “delimiter” or contemplate that a delimiter could even be used to denote the end to an entry of an abbreviated textual command. As such, the specification does not disclose the ability to exclude such a command-ending delimiter.

Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) (“[the] specification, having described the whole,

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necessarily described the part remaining.”). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984) (*MPEP 2173.05(i)- any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement*).

The dependent claims 49-50 fail to overcome the 35 U.S.C. 112, first paragraph rejection directed towards independent claim 48, and thus are also rejected as failing to comply with the written description requirement.

(10) Response to Argument

Independent claim 2

The appellants begin their arguments by focusing on the 35 U.S.C. 103(a) rejection of claim 2 over Beauregard et al (*U.S. Patent: 5,974,413*) (*hereinafter*, “*Beauregard*”) in view of Eide (“*Valet: An Intelligent Unix Shell Interface*,” 1995) (*hereinafter*, “*Eide*”) and Laursen et al (*U.S. Patent: 6,288,718*) (*hereinafter*, “*Laursen*”) (*Appeal Brief, Pages 9-12*). The appellants arguments focus on two limitations of claim 2 in particular: (i) while receiving the command from the user, displaying a list of probable commands; and (ii) after the list is displayed, the user enters remaining characters of the command to narrow the list (*Appeal Brief, Page 9*).

In regards to these limitations the appellants first argue that in their claimed invention enables a list of probable commands to be displayed "before the user enters any sort of indication that the abbreviated textual command has been completely

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entered (*e.g., by pressing enter or some other type of delimiter denoting an end of the text string*). In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (*i.e., "pressing enter or some other type of delimiter denoting an end of the text string"*) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Also, it is noted that even if such claim language was incorporated into claim 2, it would lack a corresponding written description in the specification (*see below response directed towards the 35 U.S.C. 112, first paragraph rejection*).

The appellants' arguments, however, are based around the unclaimed non-entry of a "delimiter". On Page 10 of the Appeal Brief, the appellants argue that in Beauregard a user is only offered a list of possible commands after they have indicated the end of a command entry via a delimiter. The appellants also equate the displaying "while the command text is entered" to the non-entry of a delimiter and argue that the examiner has, at different points said that this limitation was taught by Beauregard and Eide.

In response, the examiner notes that claim 2 does not require that a list of probable commands is displayed without entering a "delimiter". Instead, claim 2 merely requires that such displaying is performed "while receiving the abbreviated textual command". Before addressing this argument, the examiner notes that Beauregard was not explicitly relied upon for teaching such a limitation. The appellants point to the

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5/23/2008 Office Action as relying upon Beauregard for teaching "while receiving the abbreviated textual command", but the examiner notes that this recitation was merely the result of a direct copying of the claims into the rejection for purposes of mapping (*this position is further evidenced by the fact that no mapping is associated with this claim recitation, see 5/23/2008 Office Action, Page 9*) and that this is not the examiner's position (*"the ability for a user to ignore a list of suggested completions [and] continue typing until text entry is completed is more specifically taught by Laursen", 5/23/2008 Office Action, Pages 3-4*).

Specifically, Beauregard teaches a text command entry system that allows a user to enter abbreviated text commands (*for example, "wp" for word processor*) to execute software scripts (*Col. 7, Lines 58- Col. 8, Line 49; and Col. 43, Lines 1-13*) upon searching/matching in a word database (*Col. 16, Line 65- Col. 17, Line 31*).

Beauregard also teaches that his invention has the ability to suggest multiple candidate commands as a completion to an input command (*Col. 42, Lines 27-50*). The deficiency in Beauregard is that in order for these completions to be suggested the user must first enter a delimiter (*Col. 9, Line 9*). Eide, however, does teach the ability to suggest possible completions for a command *during* its entry. On Page 37 of Eide, an example is provided which illustrates this ability. As a user is entering a full command (*i.e., during the process of command entry*) "ls sources" they may hit a key such as tab while still entering the command (*i.e., "ls sou" has been incompletely entered*) to enable the system to display a "list of possible completions" (*Page 37, especially footnote 3*). The appellants' position is that this list is not produced during command entry or "while" a

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command is being received, but, their arguments are based upon the non-entry of a delimiter which is not recited in claim 2 or described in the specification. The only requirement in the claims is that the list be produced while a command is being entered and in Eide, this is certainly the case because when the list of commands is presented to a user, the user is still in the process of entering the command (*i.e., the complete command has not yet been entered into the system- "ls sou"*).

Most pertinent to the above arguments, however, is the teachings of Laursen. Laursen recites the ability to enter text and concurrently view a consecutively narrowed list of possible completions (*Abstract; Col. 2, Lines 1-24; and Col. 6, Line 34- Col. 7, Line 12*). In Laursen for "every character the user enters, a progressively reduced list of indexes that start with the entered characters is displayed" (*Abstract*). In arguendo then, even assuming that non-entry of a delimiter was claimed and supported in the specification, Laursen provides this teaching.

The appellants next argue the limitation "entering remaining characters of a command after the list is displayed" (*Appeal Brief, Pages 11-12*). In support of this position, the appellants argue that Laursen, which was relied upon for the teaching of this limitation in combination with the teachings of the other prior art references, fails to teach a list of probable "commands" because Laursen instead allegedly narrows a list of names in an address list (*Appeal Brief, Page 11*).

In response, the examiner notes that the concept to which the appellants are referring (*i.e., narrowing down a list of displayed completions as successive characters are entered after an initial completion list is displayed*) would be familiar to anyone who

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has ever utilized an address book in a cellular phone. Cell phones commonly use an address book feature where a user can begin entering text for the name of a person they wish to call and, as the characters are entered, a list of possible completions are narrowed. Beyond just being well known in the art, in the present rejection the concept relied upon in the appellants' claimed invention is taught by Laursen. Laursen specifically describes that for "every character the user enters, a progressively reduced list of indexes that start with the entered characters is displayed" (*Abstract*). Laursen is only relied upon for the concept of narrowing down a displayed list of text entry completions as characters are entered. As was noted above, both Beauregard and Eide are concerned with and relied upon for entering text in the form of commands. Thus, it is the combination of the prior art yields successively narrowing down a list of text completions as text is entered by a user, wherein as per the teachings of Beauregard and Eide, text is in the form of abbreviated commands. In response to this argument against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Next, the appellants provide several reasons as to why one of ordinary skill in the art would not modify the teachings of Beauregard with the teachings of Laursen (*Appeal Brief, Pages 11-12*). The examiner submits that these arguments are not convincing for the following reasons:

Argument 1) In Laursen, text is directed to a person's name, whereas in Beauregard, the text is a computer command (*Appeal Brief, Page 12*). In response, the examiner notes that both types of entries are based on *text relying on alphanumeric characters forming words (see Fig. 3 of Laursen and Fig. 23 of Beauregard)*, thus the functionality of Laursen, which relies on the beginning letters of the partial user entry (*Col. 2, Lines 1-24*) could easily be applied to Beauregard because Beauregard also relies on a similar text input via keystrokes (*Col. 7, Line 58- Col. 8, Line 49*). In Laursen, the characters gradually entered by a user are compared against the database of words and used to display text entries that begin with those same letters (*Col. 2, Lines 1-24*). In Beauregard, the letters of the text-based command words could easily be processed in the same fashion (*i.e., commands indexed to the same letters would be retrieved as letters are gradually entered*). Also, the inclusion of this feature in Beauregard provides a clear benefit of allowing pertinent text information (*i.e., a command in the case of Beauregard*) to be retrieved "quickly and efficiently with minimum keystrokes" (*Laursen, Col. 2, Lines 22-24*). In addition, because Beauregard and Laursen both deal with text entry and Laursen describes the result of how a list of completions for text entry can be narrowed upon entry of successive characters, their combination would yield predictable results (*"[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results. "Id. at ___, 82 USPQ2d at 1395*). It would not be any stretch of the imagination that since Laursen deals with displaying completions for entered text, Laursen could be extended to completing other types of text entry such as commands in

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the case of Beauregard. Thus, since both prior art references are directed to text entry and Laursen could be easily combined with Beauregard in order to achieve a clear benefit and predictable result that is recognizable to one of ordinary skill in the art, the appellants' arguments have been fully considered, but are not convincing.

Argument 2) In Laursen, text is entered in response to a query whereas in Beauregard text is entered on the user's own volition (*Appeal Brief, Page 12*). In response, the examiner notes that the type of data entry of both prior art references is directed to *text entry*. As explained above, the alphabetical lookup of Laursen could easily be applied to Beauregard because of this similarity which would yield predictable results and for a benefit that would be recognizable to one of ordinary skill in the art from the explicit benefit noted in the Laursen reference ("*quickly and efficiently with minimum keystrokes*," Laursen, Col. 2, Lines 22-24). Thus, this argument has been fully considered, but is not convincing.

Argument 3) The type of text entry in Laursen is pre-defined, whereas in Beauregard it is any function or application that the computer supports (*Appeal Brief, Page 12*). In response, the examiner notes that both text objects are directed to a list of text entries and both sets are finite. In Beauregard this list is a list of commands that "the computer supports" and is *text* based and can easily incorporate the more efficient entry means taught by Laursen for the reasons noted above (*both text based, yields predictable results, and based on the teachings found in Laursen*). Thus, this argument has been fully considered, but is not convincing.

Argument 4) Laursen deals with unabbreviated words, while those in Beauregard are abbreviated (*Appeal Brief, Page 12*). In response, the examiner notes that since both text sets still deal with *alphanumeric text-based characters* and Laursen teaches the concept retrieving complete entries indexed to a portion of the text as is noted above, it would not matter whether text was abbreviated, it would only matter that the entry was text-based. In other words, Laursen would simply look at the text that was entered, match the entry with possible completions, and successively display lists for those entries (*Abstract and Col. 2, Lines 1-24*) whether the input text was abbreviated or not (*in the case of Beauregard, they are abbreviated, Col. 7, Lines 50-63*). Thus, this argument has been fully considered, but is not convincing.

For at least the above reasons, the examiner finds the appellants' arguments directed towards claim 2 to be unconvincing.

Independent claim 37

The appellants traverse the art rejection of claim 37 for reasons similar to claim 2 (*Appeal Brief, Pages 12-13*). In regards to such arguments, please see the response directed towards claim 2.

Independent claim 48

The appellants traverse the art rejection of claim 48 for reasons similar to claims 2 and 37 (*Appeal Brief, Pages 13-14*). In regards to such arguments, please see the response directed towards claim 2 (*particularly the response directed towards the non-*

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entry of a delimiter in Laursen). The appellants additionally agree that one of ordinary skill in the art would not look to modify Beauregard with the teachings of Laursen (*Appeal Brief, Pages 13-14*). In regards to such arguments, please see the explanation of why one of ordinary skill would look to combine Beauregard and Laursen for the benefit explicitly described by Laursen and the predictable results such a combination would yield.

35 U.S.C. 112, First Paragraph Rejection

On Page 14 of the Appeal Brief, the appellants argue that the claim limitation "the comparing and initiating steps being performed without the using having entered a delimiter denoting an end of the text string" in Claim 14 is supported in the specification on Pages 8-9 and Fig. 6. The appellants further argue that in the Final Office Action 12/4/2008, the "Examiner concludes that the element of claim 48 relating to the delimiter is not supported in the specification and states that "the new matter rejection has been set forth below". However, the Office Action does not include a new matter rejection." The examiner notes that in the aforementioned Office Action (*Page 7*) there was a clear intention to set forth a new matter-type 35 U.S.C. 112, first paragraph rejection of claims 48-50 in reply to the appellants' 8/15/2008 amendment which added the claim language lacking written description. On Page 7, rationale was provided in support of a 35 U.S.C. 112, first paragraph rejection, but as a result of an oversight the formal rejection was never made in the Office Action. Also, it is pointed out that the appellants had sufficient opportunity to consider this rejection as similar new matter limitations were added and

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rejected under 35 U.S.C. 112, first paragraph during prosecution history (*please see the claim 2 amendment from 5/3/2007, the corresponding rejection from 7/26/2007, Pages 4-5, and the cancellation of the same in claim 2 from the 10/24/2007 amendment*).

Accordingly, to correct this oversight a new grounds of rejection, similar to the one found in the 7/26/2007 Office Action, has been set forth in this Examiner's Answer.

The appellants' awareness of the examiner's position on the 35 U.S.C. 112, first paragraph rejection of claims 48-50 is further evidenced by their arguments in the present Appeal Brief. Here, they argue that the non-entry of a delimiter is supported by pages 8, lines 2-4 and 9, lines 1-5 along with Fig. 6 (Appeal Brief, 14). In response, the examiner notes that a reading of the cited passages and even a careful consideration of the entire specification readily reveals that there is no recitation of any type of delimiter, particularly the use of a delimiter in denoting the end of a text string. This lacking recitation is important because the delimiter and its function in claim 48 is in regards to a negative limitation (*i.e.*, "*without the user having entered a delimiter denoting an end of the text string*"). Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ("[the] specification, having described the whole, necessarily described the part remaining."). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984) (*MPEP 2173.05(i)- any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply*

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with the written description requirement). Since there is no positive recitation of the use of a delimiter in denoting an ending of a text entry or even a mention of a delimiter in the specification, the applicant's argument is unconvincing and the examiner submits that the new grounds of rejection of claims 48-50 under 35 U.S.C. 112, first paragraph is proper.

Independent claim 56

The appellants traverse the art rejection of claim 56 with regard to the limitation "displaying a list of frequently used commands from the database as soon as the user beings entering the command text string, for the user to select one of the commands from the list" (*Appeal Brief, Page 15*). In support of their position the appellants allege, similar to their arguments directed towards the Laursen reference, that Snapper et al (*U.S. Patent: 7,216,292*) (*hereinafter, "Snapper"*) "does not teach displaying probable commands while the user enters a command string; in fact Snapper is irrelevant to entering commands" and instead deals with entering "personal information" (*Appeal Brief, Page 16*).

The examiner points out that just as in the case of Laursen, Snapper is concerned with entering text into an interface ("*typing*", *Col. 10, Lines 45-60*). Snapper also explicitly describes that the "user can begin typing, causing the list to be narrowed down to those choices that continue to match the succeeding characters entered" (*Col. 10, Lines 45-60*). Thus, Snapper teaches displaying a frequently used list of text entries as soon as the user beings typing. It can been seen then that the appellants narrowing

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feature, regardless of whether it regards commands or not, provides nothing novel or non-obvious over other text-based list proposals for entry completion because they all involve text entry (*the appellants own claim 56 sets forth that the entry is a "text string"*). The only difference between the teachings of Snapper and the appellants' claim 56 is that the text relates to commands. As pointed out above, Beauregard deals with text in the form of commands (*see Fig. 4C of Snapper which shows that as soon as a user enters a "J" a list of possible J completions are displayed and Fig. 23 of Beauregard*). Thus, since Snapper teaches the aforementioned claim limitations regarding narrowing a list of possible completions as soon as a user begins entering text and Beauregard teaches text in the form of commands, the appellants arguments have been fully considered, but are not convincing. Also, in response this argument against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Next, similar to their analysis regarding Laursen, the appellants provide several reasons as to why one of ordinary skill in the art would not modify the teachings of Beauregard with the teachings of Snapper (*Appeal Brief, Pages 16-17*). The examiner submits that these arguments are not convincing for the following reasons:

Argument 1) In Snapper, text is directed to a user's personal information, whereas in Beauregard, the text is a computer command (*Appeal Brief, Page 12*). In response, the examiner notes that both types of entries are based on *text relying on*

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alphanumeric characters forming words (see Fig. 4C of Snapper and Fig. 23 of Beauregard), thus the functionality of Snapper, which relies on the beginning letters of the partial user entry (*Col. 10, Lines 45-60 and Fig. 4C*) could easily be applied to Beauregard because Beauregard also relies on a similar text input via keystrokes (*Col. 7, Line 58- Col. 8, Line 49*). In Snapper, the characters gradually entered by a user are compared against the database of words and used to display text entries that begin with those same letters with respect to a frequency-of-use (*Col. 8, Lines 5-12, Col. 13, Line 59- Col. 14, Line 5; Col. 9, Lines 4-27; and Col. 10, Lines 45-60*). In Beauregard, the letters of the text-based command words could easily be processed in the same fashion (*i.e., commands indexed to the same letters would be retrieved as letters are gradually entered*). Also, the inclusion of this feature in Beauregard provides a clear benefit of allowing pertinent text information (*i.e., a command in the case of Beauregard*) to reduce the need for a user to repeatedly enter a complete text input (*Snapper, Col. 1, Lines 25-34*). In addition, because Beauregard and Snapper both deal with text entry and Snapper describes and shows (*Fig. 4C*) the result of how a list of completions for text entry can be narrowed upon entry of successive characters, their combination would yield predictable results (*"[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results. "Id. at ___, 82 USPQ2d at 1395*). It would not be any stretch of the imagination that since Snapper deals with displaying completions for entered text, Snapper could be extended to completing other types of text entry such as commands in the case of Beauregard. Thus, since both prior art references are directed to text entry and

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Snapper could be easily combined with Beauregard in order to achieve a clear benefit and predictable result that is recognizable to one of ordinary skill in the art, the appellants' arguments have been fully considered, but are not convincing.

Argument 2) In Snapper, text is entered in response to a website's query whereas in Beauregard text is entered on the user's own volition (*Appeal Brief, Page 16*). In response, the examiner notes that the type of data entry of both prior art references is directed to *text entry*. As explained above, the database lookup in Snapper could easily be applied to Beauregard because of this similarity which would yield predictable results and a benefit that would be recognizable to one of ordinary skill in the art from the explicit benefit noted in the Snapper reference (*Col. 1, Lines 25-34*). Thus, this argument has been fully considered, but is not convincing.

Argument 3) The type of text entry in Snapper is pre-defined, whereas in Beauregard it is any function or application that the computer supports (*Appeal Brief, Page 16*). In response, the examiner notes that both text objects are directed to a list of text entries and both sets are finite. In Beauregard this list is a list of commands that "the computer supports" and is *text* based and can easily incorporate the more efficient entry means taught by Snapper for the reasons noted above (*both text based, yields predictable results, and based on the teachings found in Snapper*). Thus, this argument has been fully considered, but is not convincing.

Argument 4) Snapper deals with unabbreviated words, while those in Beauregard are abbreviated (*Appeal Brief, Page 16*). In response, the examiner notes that since both text sets still deal with *alphanumeric text-based characters* and Snapper teaches

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the concept retrieving complete entries indexed to a portion of the text as is noted above, it would not matter whether text was abbreviated, it would only matter that the entry was *text-based*. In other words, Snapper would simply look at the text that was entered, match the entry with possible completions, and successively display lists for those entries (*Col. 10, Lines 45-60; and Fig. 4C*) whether the input text was abbreviated or not (*in the case of Beauregard, they are abbreviated, Col. 7, Lines 50-63*). Thus, this argument has been fully considered, but is not convincing.

Argument 5) In Snapper, the browser can reasonably assume that the entry to a finite field, which is allegedly irrelevant to Beauregard which enters commands in free form (*Appeal Brief, Page 17*). In response, the examiner again points out that both text sets still deal with *alphanumeric text-based characters* and Snapper teaches the concept retrieving complete entries indexed to a portion of the text as is noted above. This teaching of Snapper is what is relied upon in the prior art rejection and not the introduction of form fields. Thus, since both prior art references are directed to text entry and Snapper could be easily combined with Beauregard in order to achieve a clear benefit and predictable result that is recognizable to one of ordinary skill in the art, the appellants' arguments have been fully considered, but are not convincing.

For the above reasons, the examiner finds the appellants' arguments directed towards claim 56 to be unconvincing.

Dependent Claims

The appellant has traversed the art rejection directed towards the dependent claims for reasons similar to the independent claims (*Appeal Brief, Page 17*). In regards to such arguments, see the corresponding responses directed towards the independent claims.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

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(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/James S. Wozniak/

Primary Examiner, Art Unit 2626

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/Matthew C Bella/

Acting Director, TC 2600

Conferees:

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/JSW/,